

REMARKS

Claims 1, 5-6, 8-10, 13-14, 16-17 and 19-23 are pending. Claims 1 and 10 are amended. Claims 2-4, 7, 11-12, 15 and 18 are canceled without prejudice to or disclaimer of the underlying subject matter. No new matter is introduced.

The claims have been amended to include features that were previously in the dependent claims. Specifically, independent claim 1 has been amended to include features of dependent claims 3 and 4 (now canceled) and independent claim 10 has been amended to include features of dependent claims 11 and 12 (now canceled). Therefore, Applicant submits that the pending claims do not require the Examiner to conduct another search. Applicant respectfully submits that this amendment is filed under and is in compliance with 37 C.F.R. § 1.116, and requests that this amendment be entered.

The Application is placed in condition for allowance. Applicant requests the Examiner to reconsider and withdraw all outstanding grounds of rejection. Applicant respectfully requests allowance of the application.

On page 3 of the Office Action, claims 1, 3-6, 8-14, 16-17 and 19-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Publication No. US 2002/0046386 to Skoll et al. (hereinafter "*Skoll*") in view of U.S. Patent No. 6,263,480 to Bartels et al. (hereinafter "*Bartels*"). These rejections are respectfully traversed.

With respect to independent claims 1, 10 and 19, Applicant respectfully submits that the Office Action does not establish a prima facie case of obviousness as required by the MPEP. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, finally the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 706.02 (j).

Applicant respectfully submits that the Office Action does not establish a prima facie case of obviousness since neither *Skoll* nor *Bartels*, either separately or in combination, disclose or suggest all of the features of the claimed invention. For example, neither *Skoll* nor *Bartels* disclose or suggest "if the short circuit exists, determining a location of the short circuit by: evaluating a schematic text file associated with the circuit to identify each connection in the circuit; creating a copy of the artwork of the circuit; inferring and renaming

labels, associated with each identified connection, in the copy of the artwork,” as recited, among other features, in independent claim 19.

The Office Action states at paragraph 13 that *Skoll*, at Figs. 15A and 15B, discloses “if a short exists[,] determining it’s location [by] evaluating a schematic text file associated with the circuit to identify each connection,” as claimed. However, Figs. 15A and 15B of *Skoll* and associated test do not disclose or suggest the claimed features. Specifically, paragraph 107 of *Skoll* states that the design analysis workstation 210 also provides a facility for extracting design information from interconnected annotation objects. The extraction of design information is used to generate a net-list of components and connections. FIGS. 15A and 15B are schematic diagrams illustrating the generation of a net-list from interconnected annotation objects on an annotation overlay shown in FIG. 15A. Generating the net-list produces a net-list document shown in FIG. 15B. *See Skoll*, paragraph 107.

Evaluating a schematic text file associated with the circuit to identify each connection in the circuit and inferring and renaming labels, associated with each identified connection, in the copy of the artwork, as claimed, is not that same as extracting design information from interconnected annotation objects (shown in FIG. 15A) and using the extracted information to generate a net-list of components and connections (shown in FIG. 15B), as disclosed in *Skoll*. If fact, it is completely the opposite. Therefore, *Skoll* fails to disclose or suggest at least this feature of the claimed invention.

Bartels fails to overcome those deficiencies of *Skoll* described above. For example, *Bartels* does not disclose or suggest, at least, evaluating a schematic text file associated with the circuit to identify each connection in the circuit and inferring and renaming labels, associated with each identified connection, in the copy of the artwork, as claimed.

Applicant submits that the Office Action fails to establish a prima facie case of obviousness since neither *Skoll* nor *Bartels*, applied separately or in combination, disclose or suggest all of the features of the claimed invention. Therefore, Applicant respectfully submits that independent claim 19 is patentably distinguishable over the applied art for at least the reasons indicated above and is in condition for allowance.

With respect to independent claims 1 and 10, Applicant respectfully submits that the applied art, either separately or in combination, does not disclose or suggest, at least, “examining a schematic of the circuit, where in the examining includes evaluating a connectivity text file of the schematic and obtaining electrical connection information for each component in the circuit,” as recited, among other features, in independents claims 1 and 10 (as presented). As noted above, independent claim 1 has been amended to include the

features of dependent claims 3 and 4 (now canceled), and independent claim 10 has been amended to include the features of dependent claims 11 and 12 (now canceled). The Office Action uses the same reasoning, to reject dependent claims 3 and 4, which is used to reject certain features of independent claim 19. As described above, neither *Skoll* nor *Bartels* disclose or suggest these features of the claimed invention. The applied references, applied separately or in combination, do not disclose or suggest, at least, "evaluating a connectivity text file of the schematic and obtaining electrical connection information for each component in the circuit," as claimed. Therefore, Applicant respectfully submits that independent claims 1 and 10 (as presented) are patentably distinguishable over the applied art for at least the reasons indicated above and are in condition for allowance.

Claims 5-6 and 8-9 depend from independent claim 1, claims 13-14 and 16-17 depend from independent claim 10, and claims 20-23 depend from independent claim 19. Therefore, dependent claims 5-6, 8-9, 13-14, 16-17 and 20-23 are allowable for the reasons stated above, and for the additional features recited therein.

CONCLUSION

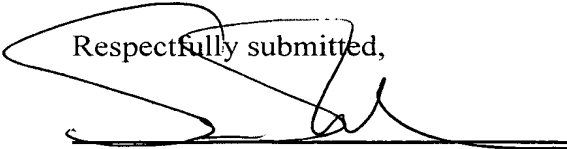
In view of the above amendments and remarks, Applicant believes that all of the rejections against this application have been fully addressed and that the application is now in condition for allowance. Therefore, withdrawal of the outstanding objections and rejections and a notice of allowance for the application are respectfully requested.

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's deposit account no. 08-2025.

Should the Examiner believe that anything further is required to expedite the prosecution of this application or further clarify the issues, the Examiner is requested to contact Applicant's attorney at the telephone number listed below.

Respectfully submitted,

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